

REMARKS

The Examiner has required restriction of the claimed invention and has requested group, subgroup and species elections.

Group & Subgroup Election

The Examiner has indicated that the following inventions or groups of inventions “are not so linked as to form a single general inventive concept under PCT Rule 13.1” (Office Action, page 2):

Group	Claims	Description
I	1-33, 35, 36, 41-69	methods comprising detecting changes in binding of a first cytoskeletal component to a second component;
II	34	methods comprising detecting changes in binding of \geq two first cytoskeletal components to \geq second components; and
III	37-40	methods comprising detecting changes in coupling between ATP hydrolysis and force generation.

The Examiner has also indicated that each of Groups I, II and III read upon patentably distinct groups, each representing a different pairwise combination of cytoskeletal component. The Examiner has requested that Applicants provide elected first and second cytoskeletal components as a further restricted Group. In particular, the Examiner states that the “technical feature linking the claims is anticipated by reference of WO 94/08041, [of] Inventor Woo” (Office Action, page 4).

Applicants hereby elect to prosecute the claims of **Group III (Claims 37-40)**, with **traverse** of the requirement for a further restricted Group. Applicants respectfully remind the Examiner that the:

expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art (PCT, Rule 13.2).

Applicants submit that the Examiner has made an improper lack of unity finding with respect to the further restricted Group (pairwise combination of cytoskeletal components), as the Examiner has failed to provide evidence that the claims of Group III without further limitation lack special technical feature(s).

In particular, Claims 37-40 of Group III reading upon all pairwise combinations of cytoskeletal components of Table 1, are directed to “detecting a change in coupling between ATP hydrolysis and force generation; wherein said change indicated that said compound modulates activity of a cytoskeletal system.” In contrast, the prior art PCT Publication of Woo fails to teach or suggest any methods for **measuring ATP hydrolysis** (*e.g.*, ADP release) and fails to teach or suggest any methods for **measuring force generation** (*e.g.*, motor binding). Thus, the special technical feature of detecting a change in the relationship between ADP release (ATP hydrolysis) and motor binding (force generation/motility) clearly distinguishes the claims of Group III from the prior art. As such the request for a further Group election is improper.

Further evidence of the inappropriateness of the lack of unity finding is provided by the International Search Report (ISR) of the parent International Application No. PCT/US98/18368 (to which priority is claimed) mailed by Examiner Achutamurthy of the U.S. International Search Authority on December 30, 1998. As can be observed in the ISR published with the parent application as WO 99/11814, Examiner Achutamurthy correctly examined all of Claims 1-69 without issuing an Invitation to Pay Additional Fees (indicative of a finding of unity of invention).

Species Election

In addition, the Examiner has indicated that the instant Application contains claims directed to more than one species of the generic invention. For the purposes of examination, Applicants hereby elect components of the microtubule system, ATPase assays, and test compounds that can be classified as lead therapeutics for human disease. Applicants respectfully remind the Examiner that upon allowance of a generic claim, that Applicants are entitled to consideration of claims to additional species (*e.g.*, cytoskeletal polymers, motor proteins, cytoskeletal polymer binding proteins, actin/myosin system components, etc), which are written in dependent form or otherwise include all the limitations of an allowed generic claim, as provided by 37 CFR 1.141.

Information Disclosure Statement

Applicants request consideration of the references listed on the Information Disclosure Statement submitted to the Office on March 25, 2003, and received by the Office on March 31, 2003, before mailing of a first substantive Office Action.

Conclusion

Applicants hereby elect to prosecute the claims of **Group III (Claims 37-40) with traverse**, and further elect components of the microtubule system, ATPase assays, and test compounds that can be classified as lead therapeutics for human disease, as species for the purposes of examination. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicants encourage the Examiner to call the undersigned collect.

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By: _____



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